REMARKS

Claims 83 - 102 are pending.

The rejections are again traversed based on the explanations and arguments below. Reconsideration is respectfully requested.

Response to rejection of claims 83 – 87, 92 and 96 in light of Cohen (US 5,769,948)

As noted in prior responses, the above claims were rejected solely under 102(e). The rejection was traversed based on Applicant's contention that Cohen does not in fact teach:

> "..wherein the author of the email message can direct that the email message be transmitted even if words in such email message still fall within said language filter.

In response to this traverse the Examiner has now argued that this limitation is found in Cohen "inherently" – see page 2 of the Office Action. However the only support that the Examiner cites for this proposition is set out in page 5 of the Office Action where he claims that Cohen shows that the author of a document can still direct ".....to send the message to be transmitted, despite the undeliverable message." In other words, the Examiner claims that there is some mechanism or vehicle for authors in Cohen to bypass the security of such system and somehow deliver messages outside of the control measures imposed by such architecture.

With all due respect, the Examiner is improperly speculating and inferring structure/operations in the prior art reference which are clearly not present. This is not sufficient to support an "inherency" theory of anticipation.

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is ***necessarily*** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added); see also Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347 (Fed. Cir. 1999); Abbott Laboratories v. Geneva Pharmaceuticals, Inc., 182 F.3d 1315 (Fed. Cir. 1999) (emphasis added). Here there is nothing to suggest, let alone compel the conclusion that Cohen's system allows such operation.

Moreover the Examiner's interpretation of the reference contradicts the plain teaching of Cohen, further demonstrating that not only is not "inherent" in such reference, it in fact teaches away from the behavior that the Examiner now imbues it with. Cohen specifically

mandates that the user must remove/edit the content (words) of the message before it can be transmitted:

> "....At step 520 the user edits said selected file 480, **therein "editing out" profane language** that is captured in brackets (see steps 270 and 280, FIG. 2). Said brackets thereby serve the user in locating and eliminating the profane language that had previously prevented the message from being sent. At step 530, **the edited message may be filed** (step 90, FIG. 1) and the user given the option to re-send said message (step 120, FIG. 1) (emphasis added).

This can be confirmed from examining block 520 in FIG. 5; EVERY offending message in Cohen MUST be edited to pass the profanity filter or it will not be transmitted. Again, the present claim is directed to a more flexible approach.1

The Examiner contends that the author in Cohen could somehow nonetheless transmit the message; but the Examiner does not cite any support in the reference for such proposition. There is absolutely nothing in Cohen which allows for directing a message to be transmitted after being rejected as undeliverable. Moreover while it is possible that Cohen could be modified to operate in the manner the Examiner suggests, there is no teaching or hint to this effect anywhere in such reference or the other prior art. Inherency may not be established, by probabilities or possibilities regarding what may have resulted in the prior art. In re Oelrich, 666 F.2d 578, 212 USPQ 323, 326 (CCPA 1981).

Consequently Applicant submits that anticipation under the "inherency" argument cannot be supported based on Cohen, and for that reason the claim is clearly allowable.

Dependent claims 84 – 87 and 92 should be allowable for at least the same reason.

Independent claim 96 contains a similar limitation as claim 83 and thus should also be allowable for substantially the same reason.

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1 No admission or inference should be drawn from the present record as to the nature or scope of other claims issued or pending to the Applicant to such subject matter which do not specifically recite the language at issue here.

Response to rejection of claims 88 - 89 and 97 in light of Cohen (US 5,769,948) taken with Ishikawa (5,812,863)

Claim 88 depends from claim 83, and as such should be allowable for at least the same reason as the latter.

With respect to dependent claims 89 and 97; to make the distinction more apparent, Applicant has amended the claims to make it clear that there are two separate files for the two separate dictionaries. Again Ishikawa does not show separate files for dictionaries; a single dictionary file is used which contains words with multi-value codings.

Response to rejection of claims 90, 91, 93, 98 and 99 in light of Cohen (US 5,769,948) taken with Russell – Falla (6,675,162)

Claims 90, 91 depend from claim 83, and as such should be allowable for at least the same reason as the latter.

Concerning independent claim 93; the Examiner cites col. 5, ll. 33+ of Russel – Falla for the proposition that it teaches alerting an author of a document if a sensitivity threshold specified by the author is exceeded. The Examiner now states that if the user is a "parent, guardian or administrator" the limitation is inherently met.

The Examiner fails to explain what the identity of the browser user/configurer has to do with the limitations of the present claim. Whether the user is a child or guardian does not change the fact that Russell – Falla is directed to controlling behavior of the browser, and says nothing about participation or input by the authors of the underlying documents (webpages) reviewed by the browser.

The authors of the documents (web page) have no access to the ratings used by the browser filter, nor any mechanism for ensuring that the page (document) will comply with such threshold. In fact, if such were possible it should be apparent to the Examiner that Russel-Falla would fail to achieve its intended purpose because the authors could manipulate such browsers to render and present documents which may be incompatible with the filtering goals of such reference.

For this reason Applicant again reiterates that Russell – Falla is directed to a very

different scenario, and says nothing about this limitation of claim 93:

> ....(b) setting a sensitivity threshold provided by the author to also be used in connection with checking appropriateness of content included in the email message;...

Since the Examiner does not claim that the web page authors provide the sensitivity thresholds, this claim cannot be made obvious or anticipated.

Accordingly this claim is believed to be distinguishable over the cited combination, which does not permit the author of the document to adjust a sensitivity threshold.2

Claims 98 – 99 should be allowable for essentially the same reasons as claim 93.

Response to rejection of claims 94, 95 and 100 - 103 in light of Cohen (US 5,769,948) taken with Rayson (5,761,689)

Independent claims 94 – 95 should be allowable for the same reasons as claim 83 previously discussed.

Moreover with respect to the argument that Rayson can be combined with Cohen, the Examiner notes that Rayson explains the benefits of providing filtering/corrections based on indications relating to time intervals, and on that basis would be combined with Cohen. What the Examiner did not consider, however, is that Rayson is basically only checking for spelling in his embodiment, and does not suggest anywhere that this technique should be used for more comprehensive context based review of words to see if they are nonetheless offensive and/or potentially inappropriate.

Independent claim 100 should be allowable for the same reasons as claims 83 and 94 – 95 previously discussed. Dependent claim 101 should be allowable for at least the same reasons.

Independent claim 102 should be allowable for the same reasons as claims 83, 94 – 95 and 100 previously discussed, and for the reasons set out in the prior response.

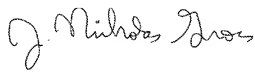
Dependent claim 103 should be allowable for at least the same reasons.

CONCLUSION

The references and rejections have been addressed in detail, and Applicant submits that he claims should be allowable over the same.

Should the Examiner believe it that it would be helpful to discuss any of the above points in person, Applicant is open to a telephone conference (510 – 540 - 6300) at any convenient time.

Respectfully submitted,



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2 Again no admission or inference should be drawn from the present record as to the nature or scope of other claims issued or pending to the Applicant to such subject matter which do not specifically recite the language at issue here for this claim.